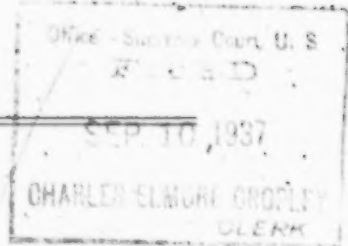


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IN THE
Supreme Court of the United States,

OCTOBER TERM, 1936.

No. 1008.

72

CROWN CORK & SEAL COMPANY, INC.,
Petitioner,

vs.

FERDINAND GUTMANN & CO.,
Respondent.

Supplemental Brief for Respondent.

WILLIAM E. WARLAND,
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Supplemental Brief for Respondent.

On page two of its reply brief, petitioner has quoted testimony given by the Commissioner of Patents on June 24th, 1937 before the Senate Committee on Patents and it is stated in a footnote (p. 2 Petitioner's Reply Brief) that a printed copy of the testimony has been filed with the clerk of this Court.

It seems clear that the principal reason petitioner filed a reply brief is to get before this Court the testimony of the Commissioner referring to the case at bar. We make no comment on the Commissioner's action in discussing a case by title which is now awaiting the decision of this Court upon an application for a writ, and giving his opinion as to what would happen on the granting or refusal of the writ.

Attention is called to the fact that the petition for the writ was filed in May, 1937, the testimony was given by the Commissioner on June 24th, 1937, while respondent's brief was not filed until July 2, 1937. Obviously the Commissioner's conclusions were made *Ex Parte*.

We emphatically protest against the action of petitioner in filing a copy of that testimony with this Court, and using

it in his brief in an obvious attempt to possibly influence the decision of this case.

Apart from quoting the Commissioner, the reply brief merely presents cumulative arguments on points already covered in petitioner's main brief, but respondent considers it advisable to answer the same in order to call attention to certain inaccurate and inconsistent statements and arguments.

It is thought it may be helpful to this Court in considering this case to very briefly restate the undisputed facts supporting the decision of the Circuit Court of Appeals for the Second Circuit, which bear on the two method patents in controversy, and upon which the petition for the writ herein is based.

Details as to the patents are as follows:

PATENT No. 1,788,260, App'n. Jan. 7, 1927, Ser. 159,743 Issued Jan. 6, 1931.

The application as originally filed described and claimed a method of applying heat by means of a heated plunger and also preheating the cork. Description and claims as to preheating the cork cancelled Dec. 3, 1930. Patent as issued described and claimed a method of "upon assembly applying simultaneously to the spot pressure and sufficient heat etc."

RE-ISSUE PATENT No. 91,117 Application filed Jan. 23, 1934 Issued March 20th, 1934.

A re-issue of Pat. No. 1,788,260. Had same claims as the parent case with two additional claims Nos. 3 and 4 calling for cooling under pressure. Held valid and infringed by the District Court. Court of Appeals reversed District Court on grounds that respondent did not use the method covered by the claims, and that if said claims were construed to cover respondent's method they would be invalid because anticipated.

APPLICATION Ser. No. 494,201 Entitled "Bottle Cap Spot Material," Filed November 7, 1930.

A division of Patent 1,788,260. As filed contained a disclosure of the "Preheating Method," but made no claims therefor. All claims were for "Bottle Cap Spot Material." These were allowed February 2nd, 1933 (pp. 1981-1985 Rec.). Lapsed for non-payment of fee. Renewed and again allowed to lapse (1996-2000) and finally abandoned.

PATENT No. 1,967,195 Application filed April 4th, 1933. Issued July 17th, 1934.

Patent states on its face "Original application November 7th, 1930, Serial No. 494,201, which in turn is a division of Serial No. 459,743, January 7th, 1927, now patent No. 1,788,260 dated January 6th, 1931. Divided and this application April 4th, 1933 Serial No. 664,410."

Referred to as the "Preheating Method" patent.

On April 5th, 1932 patent No. 1,852,578 containing 27 claims for an apparatus and 3 claims for the preheating method issued to Johnson upon an application filed November 26th, 1929.

The only claims in Patent 1,967,195 are the 3 preheating method claims copied by Warth for interference purposes.

The District Court held Patent No. 1,967,195 valid and infringed, but the Circuit Court of Appeals held that the facts above stated invited the operation of the two year rule laid down by this Court in *Webster Co. v. Splitdorf Co.*, 264 U. S. 463.

Petitioner contends that because the Circuit Court of Appeals did not expressly state there were intervening rights the doctrine of this Court in *Chapman v. Wintroath*, 252 U. S. 126 applies because Warth filed his application for the preheating method within two years of the issuance of the Johnson patent.

It is the position of respondent that the facts of this case are so different from the facts in *Chapman v. Wintroath*, *supra*, that the same does not apply.

That apart from the question of intervening rights decision of the Circuit Court of Appeals is in accordance with the established practice of the Patent Office and decisions of this and other Courts.

That in any event the Circuit Court of Appeals did in fact find that rights had intervened which made it impossible for Warth to obtain a valid patent.

POINT 1.

On the facts set forth in the opinion of the Circuit Court of Appeals its decision is clearly correct under the rule laid down by this Court in *Webster v. Splitdorf* and in accordance with a long line of decisions of this and other Courts and the well established rules of the patent office.

In an attempt to show that Warth's action in the Patent Office did not amount to abandonment, petitioner relies upon the case of *Writer v. Kiwad* in its reply brief (p. 9).

The District Court cited this case in its opinion and said (pp. 2095-6) :

"The subject matter was not abandoned, as suggested by defendant, but was specifically reserved by continuous inclusion in the divisional application, and later in the second division. This has been approved and is the usual practice. *Writer v. Kiwad*, 63 Fed. (2d) 259."

With the utmost deference to the District Court and to petitioner, it is submitted that the facts in *Writer v. Kiwad* are not in any way analogous to the facts in the case at bar and the case has not the slightest application. An inspection of the cited case shows that a parent application of *Kiwad* was filed in 1926 and claimed the invention in issue. That pursuant to a requirement of division, *Kiwad*

cancelled the claims and the drawing and descriptive matter in 1927. The Writer application was filed in November, 1928 and matured into a patent in August, 1929. Kiwad did not file his divisional application until December, 1929 after his attention was called to the Writer patent. The interference was declared on March 18th, 1930.

The case was entirely and radically different from the case at bar for the reason that Kiwad's parent application had not matured into a patent before his divisional case was filed. *The claims in the Kiwad parent application were not allowed until April, 1930, four months after the filing of his divisional application* (63 F. R. (2) at p. 264).

The co-pendency of an application containing a disclosure of the preheating method, but not claiming it, and claiming a different invention, viz, an article of manufacture only, does not entitle Warth to the date of filing of the parent case,

The argument of counsel for petitioner is of course that inasmuch as Warth had the disclosure in his co-pending application 494,201, Warth could make the claims any time within two years from the date of issue of the Johnson patent. That was the holding of the District Court and petitioner relies upon the decision of this court in *Chapman v. Wintroath* to support his argument.

The District Court erred and counsel for petitioner errs in this respect for the reason that the co-pending application 494,201 was for a *different invention*. In the case of *Jones v. Larter*, 1900 C. D. 111, 92 O. G. 383, the Commissioner of Patents said at page 115:

"The presumption of dedication to the public by disclosure in a patent may, it is true, under certain circumstances, be overcome by having a concurrently pending application claiming it; but *I know of no authority for holding that it is overcome by an application which does not and was not intended to claim it*, merely because the claims are inserted therein long after the patent on the other case issues."*

* Italics ours unless otherwise stated.

The Commissioner in his decision cited.

James v. Campbell, 104 U. S. 356, 382;

Miller v. Brass Co., 104 U. S. 350;

Mahn v. Harwood, 112 U. S. 354.

That case was followed and quoted from in the case of *Union Typewriter v. L. C. Smith & Bros.*, 173 F. R. 288, 297, affirmed by the C. C. A. 3rd Cir. in 181 F. R. 968.

As has been pointed out, application Ser. 494,201 was an application for patent on "Bottle Cap Spot Material". The claims were confined to that invention. The claims, after repeated rejection, were finally allowed. Warth could not have put claims for the *method* in that application after the patent 1,788,260 issued, under the authority of *Ex parte Stimson* 1916 C. D. page 20; 226 O. G. 699. In that case the Commissioner of Patents said:

"It appears from the remarks accompanying the amendment that when the application was prepared the process claims were deliberately omitted. The inventions are so widely different that it would be necessary to support the process claims by a supplemental oath.

No reason is seen for permitting an applicant to nullify an election deliberately made and after the application has been prosecuted to an allowance on one invention present claims for an entirely different invention, even for the purpose of interference."

Warth deliberately abandoned the invention (if it is invention) of the method of preheating the cork.

It is well settled that when an applicant is compelled by the Patent Office to accept a narrow claim, he cannot thereafter have a construction of the claim either in the same or in another application covering that which was rejected by the Office in view of the art. See the case of *I. T. S. Rubber Co. vs. Essex Rubber Co.*, 272 U. S. 429. If dissatisfied with the action of the Patent Office, he should appeal. He is bound by the claim accepted.

In the case of *Splitdorf Electrical Co. v. Webster Electrical Co.*, 283 Fed. Rep. page 83 the Court said at page 93:

"An inventor of a patent may lose his right thereto by waiver, by public grant, by estoppel, or by laches.

"By failure to apply to the government for a patent within the statutory period of two years, he loses his right as effectively as if he made specific grant thereof to the public. If in his application he seeks but a part of the claims to which he is entitled, he waives all right to those not claimed. He makes a donation to the public, and his right to the monopoly is gone forever."

That case was affirmed by this Court in 264 U. S. 463 and is relied upon by the Court of Appeals in refusing Warth the date of either the parent application of January 7th, 1927 or of the divisional application 494,201 of November 30th, 1930. Warth's prosecution of the patents here involved brings him squarely within the foregoing rule.

In the case of *Stromberg vs. Motor Devices Co. v. Benecke & Kropf Mfg. Co.*, 10 F. R. (2d) 405 (C. C. A. 2nd) an application for a divisional patent was not made until more than three years after requirement. The Court held on page 406 that in view of Sec. 4894 and 9438 R. S. an application filed more than a year after requirement for division should be treated as abandoned.

Warth by cancelling claims for and the description of the preheating method from Pat. 1,788,260 (Reissue 19,117) dedicated the part not claimed to the public. In the case of *Deering v. Winona Harvester Wks.*, 155 U. S. 286, the court said at page 296:

"It is possible that Olin was entitled to a broader claim than that to which he limited himself, but if he described and claimed only a part of his invention, he is presumed to have abandoned the residue to the public. *McClain v. Ortmyer*, 141 U. S. 419."

In the case of *Rifle Co. v. Whitney*, 118 U. S. 22, this court held that there may be abandonment of an invention after application as well as before. The court held at page 24:

"The decision of the Commissioner in favor of the applicant, upon the question whether the invention has been abandoned, is not conclusive, but may be contested and reviewed in a suit brought for the infringement of the patent."

"* * * An inventor, whose application for a patent has been rejected, and who, without substantial reason or excuse, omits for many years to take any step to reinstate or renew it, must be held to have acquiesced in its rejection, and to have abandoned any intention of further prosecuting his claim."

The case of *Vapor Car Heating Co. v. Gold Car Heating and Lighting Co.*, 296 F. R. 188 (C. C. A. 2nd), is to the same effect.

Warth is estopped by his action in the Patent Office on the application resulting in Patent 1,788,260^a from obtaining a patent at any time on the preheating method.

An inspection of the file history of the application for the parent patent (referred to on pages 13-14 of our main brief) shows that the main and, in fact, the only method considered by applicant was that of using a heated plunger. Contrary to the erroneous statements on page 27 of petitioner's main brief and page 12 of its reply brief, the original application as filed stated (p. 1490 Rec.):

"In carrying out the invention according to what is now considered the best practice the coating will be softened by heat after the crown is assembled. This may be accomplished in any suitable manner, as by a *heated plunger* or a plunger and *heated table*. The heat softens the coating and renders it adhesive and the pressure serves to unite the metal foil spot to the cork."

The claims as filed and amended did not differentiate between heating the plunger and preheating the cork. They were broad enough to cover both methods. The Patent Office in its two actions (pp. 1497 and 1500 Rec.) did not call for division as to the two methods. Nothing was said either by the Patent Office or by applicant in his amendments about

preheating the cork or alternate methods (see subdivision 10 of Amendment (p. 1524 Rec.) which describes the method and advantages of a heated plunger). The specification in referring to the preheating method simply said (p. 1490 Rec.):

"It may be desirable * * * This may be accomplished, for example, by preheating the assembled crowns."

The Patent Office held that neither method was patentable. After final rejection and appeal filed, applicant voluntarily cancelled the preheating description and took a narrow claim for all he could get, viz., the method of using a heated plunger. On the Examiner's consent and recommendation to the board to allow that single narrow claim, the appeal was withdrawn (p. 1529 Rec.).

On pages 10 and 11 of its reply-brief, petitioner, in answer to the statement in respondent's brief to the effect that the file of the parent patent shows the preheating claims and description had both been cancelled, states:

"But this contention overlooks the fact that before cancellation of the specific disclosure the same had been embodied in the divisional application filed in November, 1930. This is the only way an applicant can reserve matter cancelled from a pending application."

It is of course quite true that an applicant can file a divisional application before the parent patent issues, and we may assume that anyone looking at the file of an issued patent might be justified in thinking that some of the subject matter had been reserved in a divisional application. That is true, however, only as to the disclosure of the issued patent. If the file shows that certain matter has been cancelled both as to the disclosure and claims, the conclusion is inevitable that the applicant had abandoned the cancelled matter. If an applicant has cancelled both description and claims, as was done in the case at bar, and put in a co-pending application, Rule 43 of the Patent Office requires

that a cross reference be made to the pending application *ex parte Weston*, 390 O. G. 265. Warth did not do this. He could make no such reference because he had no application pending with claims to any method whatsoever. There is no cross reference in the file of Ser. 159,743 resulting in Patent 1,788,260. The file of that patent therefore clearly shows that both the disclosure and claims for preheating the cork were cancelled, abandoned and dedicated to the public.

By failing to appeal from the action of the Examiner in refusing in the parent application to allow the broad claims now sought to be sustained in the preheating patent, Warth is now estopped from contending those claims are valid. *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429. In *re Ellis*, 86 F. R. (2d) 412, the applicant made an application which was rejected. He filed appeal therefrom and subsequently brought a suit under Section 4915 which he failed to prosecute. The Patent Office and Court of Customs & Patent Appeals held he was estopped from making claims of the same scope in a subsequent application because he voluntarily abandoned the suit under 4915.

In the case of *In re Baker*, 74 F. R. (2d) 306 (Ct. of Customs & Pat. App.) it was held that the decision of the Commissioner of Patents rejecting certain claims in an earlier application was *res adjudicata* on the issue of patentability of substantially similar claims in a subsequent application. Failure to appeal constitutes abandonment and estoppel. *Ex parte Crane*, 32 Pat. Q. 80.

In *re Stanton*, 86 F. R. (2d) 337 certain claims were rejected in an application for reissue on the ground of estoppel because the claims were as broad or broader than claims which had been cancelled in order to secure the original patent.

In *re Crowell*, 79 F. R. (2d) 746 is to the same effect and was a case of an application for reissue of a divisional patent. It was held the applicant was estopped because the claims were substantially the same subject matter as applicant cancelled in order to obtain the original patent.

In re *Murray*, 64 F. R. (2d) 788 the Court of Customs & Patent Appeals held that if the invention involved was disclosed in an original or amended application and claims incorporating such invention were withdrawn or cancelled before the patent issued, the applicant was estopped from further claiming such invention by way of reissue.

In *ex parte Moorhead*, 173, O. G. 1079 the Commissioner of Patents held:

"Applicant is no more entitled to prosecute, after a requirement for division, claims to subject-matter which had never before been claimed though disclosed in the application and the amendment containing such claims, accompanied by a supplemental oath, than he is to prosecute claims relating to the same subject-matter as the claims which had been cancelled under the requirement for division."

In the case of *In re Woodsome & Swan*, 1926 C. D. 176; 10 F. (2d) 1003 (Ct. of App. Dist. of Col.) the application was for paper drying-rolls. Certain claims were specific claiming the steam using device as paper-drying rolls. The remaining claims were generic, calling for steam using apparatus. The Patent Office required division because of the difference in scope of the claims. The applicants took no appeal, cancelled the broad claims and the patent issued Sept. 5, 1922. Before the patent was issued and in February of 1922, applicants filed an application containing the cancelled claims and called it a divisional application. The patent was refused by the Office on the ground that to allow the second application would constitute double patenting. The action was affirmed by the Court of Appeals of the District of Columbia.

The parent case having issued Warth cannot in an application filed after its issue obtain the date of the parent case for that subsequently filed application.

In the case of *In re Spittler & Krische*, 1908 C. D. 374 a patent had issued and after its issue it was sought to obtain

its date for a divisional application on matter which was disclosed in the original patent as filed. The Court of App. Dist. Col. said at page 376:

"But having amended that application so as to conform to the ruling of the Examiner, it was merged and the patent issued thereon. After that there was no application pending in the Office as a foundation for a division. The proceeding having been closed by the issue of the patent, there was nothing to be continued. The rule which permits a divisional application to relate back to the filing date of the original which also discloses its subject matter, as long as it remains open in the Patent Office, is a very liberal one that sometimes works hardship upon intermediate inventors, and it ought not to be extended to cases not clearly within it."

In the case of *Wainwright v. Parker*, 1909 C. D. 379, 142 O. G. 1116, an application as originally presented disclosed four different species. Claims sufficient in scope to cover all were originally included, but after repeated rejections the application was limited without appeal to one of the species and the drawing, specification and claims were so amended as to eliminate all reference to the device involved in the interference. The application was allowed and went to patent. Four years afterwards the appellant filed the application in interference and sought to get the date of the original application. This was denied and the Court of Appeals said:

"His original application having eventuated into a patent, there was nothing left pending before the Patent Office upon which it could act, or to which the later application could attach."

In the case of *Conover v. Downs*, 35 F. R. (2nd) 59, (Ct. of Cus. & Pat. Appeals) Conover filed an application showing both an apparatus and a process. No claims were made to the process. The patent issued on Dec. 9th, 1919 claims for the process were made in an independent application Nov. 28th, 1921. The Court said at page 60:

"In view of the fact that the claims for the process were for a different invention, than that involved in the patent of Dec. 9, 1919, appellant was required by the Primary Examiner to cancel these claims. This ruling was accepted by appellant and the claims were cancelled. Accordingly appellant had no proper application for the invention pending in the Patent Office until he filed his independent application on Nov. 28th, 1921, nearly two years after his application of April 30, 1919 had matured into a patent. There was, therefore, no parent application pending in the Patent Office to which his application of Nov. 28th, 1921 could relate or attach."

In the case of *Model Bottling Machinery Co. v. Anheuser Busch Brewing Assn.*, 190 F. 573 C. C. A. 8th Circuit, a patent disclosed both a process and an apparatus. The patent for the apparatus issued and after its issue, an application was made and a patent obtained for the process. The Court at page 576, after quoting from the case of *Hayes-Young Tie Plate Co. v. St. Louis Transit Co.*, 137, F. 80, said:

"If, as stated in the foregoing case, the abandonment of an application destroys the continuity, and a subsequent application must be treated as a new and independent proceeding, how can it be said that there is any continuity between an application which did not make claim to the process, but only to the machine, and a subsequent application for the process."

"Among the numerous cases cited by appellant in support of the claim of continuity, we find none where it has been held that, when a patent has been issued to a party for all he claimed in his application, the party may *subsequently make a new application for a new patent upon omitted matters*, and that such new application was a continuation of the first or original application, etc."

It would seem clear, therefore, that in this case Warth having cancelled his disclosure and claims for the preheating method in order to obtain a patent, should not be al-

lowed to file a subsequent application with the preheating claims more than two years after the parent application issued without the disclosure or claims, and then be allowed the date of the application from which he cancelled them.

Petitioner cites several cases holding that a divisional application is nothing more than an amendment to the original application. Petitioner has not cited and cannot cite any case where an amendment has been made to a patent after its issue. The cases cited by petitioner do not support his argument that the application for the patent for preheating claims No. 1,967,195 is an amendment to No. 494,201 which was pending with the parent application and had the disclosure *but no claims for the method*. The application for Ser. 494,201, as has been pointed out, was for a *different invention*. It was for Bottle Cap Spot Material. It had been allowed with claims for the strip material, when the application for the preheating method was filed (p. 1985 Rec.). The rules of the Patent Office do not permit an applicant to prosecute one form of an invention and obtain allowance therefor and subsequently present claims for the first time for a different invention.

These and other authorities clearly hold that the decision of the Circuit Court of Appeals is not, as contended for by petitioner and the Commissioner of Patents, in conflict with the well established practice of the Patent Office. On the contrary, it is in strict accordance with the practice of the Patent Office.

Those decisions as well as the decisions of this court to which we have referred, hold:

1. That an inventor must be diligent in asserting claims for his invention;
2. That where an inventor acquiesces in rejection of broad claims, and does not appeal from the ruling of rejection, he is estopped from asserting the same claims or similar claims in an application filed after the patent granted on the application in which the claims first appeared;

3. That a divisional application must be filed before the parent case issues;

4. That the mere *disclosure* of the subject matter in an application copending with the parent application is insufficient to entitle the inventor to the date of the parent case, if the copending application is for a different invention than the parent and the invention is not *claimed* in the copending application.

POINT 2.

The record shows there are intervening rights. The Court of Appeals in its decision found there were intervening rights. This Court has the power to inspect the record to ascertain whether the decision of the District Court is supported by the record.

The Circuit Court of Appeals in discussing the two method patents (pp. 2150-54 Rec.) and their history in the Patent Office, said (p. 2154 Rec.);

"He (Warth) made no claim for preheating until more than two years thereafter, namely, April 4, 1933. In the meantime a patent containing claims for the preheating method had been granted to Johnson on April 5th, 1932, etc."

Because the Court of Appeals did not use the expression "intervening rights" and state in so many words that it reversed the finding of the District Court on that point, petitioner argues that it acquiesced in the conclusions of the lower court in that regard. This argument is fallacious. The language in the opinion of the Court of Appeals last quoted indicates that it did in fact consider the issuance of the Johnson patent to have given Johnson paramount rights since Warth's disclosure of the preheating method was lying

dormant and unclaimed in the Patent Office in an application for a different invention in which no claims for any method of any kind were ever made.

The Record shows and the Court of Appeals might well have held that the Cohn Patent No. 1,921,808 (p. 768 Rec.) applied for on July 20th, 1932, issued August 8th, 1933 is an intervening right. It shows the preheating method and is hereafter referred to.

In its holding, the Circuit Court of Appeals followed a long line of decisions mentioned in its opinion on page 2154 of the record. Those cases, and decisions of this and other courts, hold that an applicant is not entitled, by amendment, to so enlarge the scope of an original application as to enable him to appropriate the inventions of others.

The case of *Powers-Kennedy Co. v. Concrete Co.*, 282 U.S. 175, in its main essentials and its facts is very similar to the case at bar. It appears on page 184 of that case that McMichael recognized the priority of Leake, and, as a result, purchased and took an assignment of Leake's patent while his own application was pending, to dispose of an interference declared by the Patent Office. Leake did not offer evidence or press his claim to priority and the McMichael patent was granted in 1915, and the Leake patent in 1917, both of them, as in the case at bar, being owned by the same company. The Court said, pages 185 and 186:

"And, even if the mode of operation is as claimed, it is to be remembered that Leake in his application of October 7th, 1907, uses the same words to describe the operation of his nozzles as we find McMichael subsequently inserted in his specifications and claims. When this application came into interference with McMichael's, he, of course, became familiar with Leake's claims. It is significant that he then amended his claims, almost in the very words of Leake. This of itself destroys the patent. *Railway Co. v. Sayles*, 97 U. S. 554; *General Electric Co. v. Sangamo Electric Co.*, 174 F. 246; *Lopulco Systems Inc. v. Bonnot Co.*, 24 F. (2d) 510."

The rule announced by the Supreme Court applies with greater force against the petitioner here than it did in the cited case, for the reason that in the case at bar Warth, while originally disclosing and claiming the preheating step, cancelled them from his original application and allowed the patent to issue without either claims or disclosure for that method. Petitioner in the case at bar when it purchased the Johnson patent, as in the cited case, pressed its claim to priority on the Warth application filed subsequently to the issue of the Johnson patent.

The principle of the *Powers-Kennedy* case has been followed by this court in *Eagleton Mfg. Co. v. West-Bradley Co.*, 111 U. S. 490.

Corbin Cabinet Lock Co. v. Eagle Lock Co., 150 U. S. 38 at page 43 (a case of reissue);

Also in the following cases:

Jones v. Freed-Eismann Radio Corp., 47 F. (2d) 174 (C. C. A. 2nd);

Insulite Co. v. Reserve Supply Co., 60 F. (2d) 433 at 435 (C. C. A. 8th);

Bloodhart v. Levernier 64 F. (2d) 367 at 369 (Ct. Cust. & Pat. App.).

The petitioner, on page 5 of its reply brief, cites the case of *Adamson v. Gilliland*, 242 U. S. 350 in support of its contention that this Court cannot look into the Record. A reading of that case shows that this Court went carefully into the Record and discussed in detail the testimony of one of the witnesses. We submit therefore that the case is clearly an authority for the proposition that this Court may look into the Record to see whether the finding of the District Court is supported by the evidence.

Respondent is not asking this Court to pass upon conflicting testimony. Respondent's contention is that the documentary evidence and undisputed oral testimony of witnesses for both sides shows that the District Court erred in

concluding there were no intervening rights, and that there is no evidence to support its finding.

The findings of the two lower courts in this case are not unanimous. There was a dissenting opinion. The Circuit Court of Appeals in reversing the finding of the District Court as to infringement of Re-issue Patent 19,117 necessarily and expressly found (contrary to the finding of the District Court) (pp. 2151-2 Rec.) that defendant uses a different method, viz., a cold cutting punch and preheats the cork.

All the evidence, documentary and oral, shows that respondent had during the entire period of its manufacture of center spot crowns used the method of preheating the cork. The stipulation offered by petitioner at the opening of the trial (p. 733 Rec.) (as its only proof of infringement) shows that the method respondent used in making the alleged infringing caps, was set forth in Johnson Patent No. 1,852,578 and the Cohn patent No. 1,921,808 (p. 768 Rec.). The Cohn patent shows that it was applied for on July 20th, 1932 (while Warth's disclosure for the preheating method was lying unclaimed in the Patent Office). The Cohn patent shows the method of preheating the cork the same as in the Johnson patent. The only difference between the Johnson and Cohn patents is that the latter places the center spots on the cork discs and the cork discs in the metal shell all in one machine, whereas the Johnson patent puts the center spot on a cap, the cork disc of which has been previously secured to the metal shell in another machine (pp. 292, 392-3 Rec.)

Petitioner's own documentary evidence (Exs. 36 and 37 pp. 781-83 Rec.) in connection with petitioner's cross examination of Johnson in connection with those exhibits shows conclusively that Johnson found the heated cutting plunger unsatisfactory and eliminated it and preheated the cork in his machines in Oct., 1928 (p. 238 Rec.).

The public use proceeding instituted by Johnson during the interference between his patent and the Warth applica-

tion (Respt.'s Ex. U, p. 1121-etc. Rec.) consists of affidavits, one of them by Johnson's attorney, who prepared the application, and by his draftsman, to the effect that machines like those shown in the Johnson patent, a copy of the drawing of which was attached to the affidavit, were made as early as January, 1929. There is no evidence put in by petitioner to contradict the facts set forth in those affidavits. They were received in evidence without objection by petitioner's counsel.

There is evidence that petitioner bought five machines from Johnson between March and July 1929. An extract of the letter from petitioner ordering these machines is quoted on page 23 of our main brief. Those machines necessarily had the method of preheating the cork. As pointed out, Johnson abandoned the heated plunger in October, 1928 and preheated the cork.

Both the District Court (p. 2081 Rec.) and the Circuit Court of Appeals (p. 2153 Rec.) found that both parties in commercial practice used the method of preheating the cork. The finding of the District Court to that effect is hopelessly inconsistent with its holding that there was no sufficient evidence to show that respondent had, as testified to by its witnesses Cohn and Rasmussen (pp. 292-3, 287 Rec.) always used a cold cutting punch and preheated the cork, either by a gas flame or electrically heated plungers. The cross-examination of respondent's witnesses by counsel for petitioner (pp. 349-50 Rec.) establishes that fact. There is no evidence to the contrary.

The references made to the record by petitioner on pages 6 and 8 of his reply brief do not support the conclusions attempted to be drawn therefrom. On page 6, petitioner refers to the testimony of Cohn and argues from the references to the record that the machines bought by Johnson in September and December, 1928 and 1929 did not have the preheating device "since they are conceded to have been like the earlier 1928 machines which did not." There is no such concession either in the record nor in respondent's brief. Peti-

tioner says on page 6 that Cohn so testified about Exhibit Q and cites the record (p. 289 Q. 93). All that Cohn said was that, in addition to the mechanism for inserting the center spot, the machines had mechanism for inserting the cork disks. There is not a word about the preheating method on that page. Cohn was also shown (Q. 87 Ex. P) a bill from Johnson dated August 28th, 1931 for a machine with a standard drum.

The uncontradicted testimony of respondent's witnesses Cohn, Rasmussen and Eisen (pp. 314-16, 390, 375 Rec.) shows that a machine was bought from Johnson on July 17th, 1928 (Ex. S, p. 1108 Rec.) which did not have a drum to hold the caps after the center spot was inserted under pressure while cooling. For that reason the center spots fell off and were returned by the Goetz Company and the caps were put through the machine a second time. Another machine was bought by petitioner in August, 1928 with a standard drum (Ex. P, p. 1101 Rec.). After a cooling drum was used, no further trouble was had and the center spots stayed on (pp. 390, 375). The evidence clearly shows that respondent had always preheated the cork when applying center spots as far back as 1924-5. Petitioner's cross-examination of Cohn and the other witnesses for respondent emphasized that fact (pp. 349-50, 383 Rec.). It is submitted that it is most improper for petitioner to make statements of fact that are not supported by the record. We further protest against the statement on page 6 (Petr.'s Reply Br.) to the effect that our main brief *admits* the first two machines did not have a preheating device. An inspection of that brief (p. 20) shows that we made no such admission. We simply said that we *assumed*, for the purpose of appeal, that they did not.

IN CONCLUSION.

In opposing the application for the writ herein, counsel for respondent have to some extent discussed the merits of the whole case, but do not thereby concede that in any view of it the case can be considered a proper one for certiorari.

It is submitted that the law as to the effect of abandonment of an invention, delays in filing an application, the effect of rights that intervene during such delays, the effects resulting from the disclosure of an invention, and the failure to claim same, and the effect of public use of an article made pursuant to a certain method have been before this Court and other Courts and settled by the decisions referred to in this and our main brief. Hence, this cause does not present any questions of law which are not well settled.

The practice in the Patent Office as to the granting of patents upon divisional applications is also well settled, and the fact that the Patent Office did not follow the well settled law and practice in granting the patents here involved is not proper ground for the grant of certiorari.

It follows that the case presents no "question of federal law which has not been, but should be settled by this Court"; there is no question of public interest involved, nor is there any conflict between decisions of circuit courts of appeals within the meaning of rule thirty-eight.

The application for the writ should be denied.

Dated, New York, N. Y., September ninth, 1937.

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